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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,408	03/27/2000	KLAUS MALER	112740-421	3860
29177	7590	06/17/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/509,408

Applicant(s)

MALER, KLAUS

Examiner

Naghmeh Mehrpour

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 7-12**, are rejected under 35 U.S.C. 102(e) as being anticipate by Jarrett et al. (US Patent Number 6,735,432 B1).

Regarding **Claim 7**, Jarrett teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (col 6 lines 20-29), the communication terminal apparatus being logged on as ready to receive the selected base station (col 11 lines 43-47), the communication terminal apparatus comprising:

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recognition means for recognizing one of the at least two communication systems (col 13 lines 26-35, lines 65-66), the recognized communication system having the selected base station (col 13 lines 65-67, col 14 lines 1-5), and

control means configured to allocate a network address to the recognized communication system under which the communication terminal apparatus can currently be reached (col 14 lines 24-33) and communicating control information via the selected base station to a control network address stored in a memory (col 15 lines 33-46) of the communication apparatus (col 15 lines 33-53);

wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (col 15 lines 33-45).

Regarding **claim 8**, Jarrett teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (col 13 lines 25-35), the communication terminal apparatus being logged on as ready to receive the selected base station (col 11 lines 43-47), the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (col 13 lines 26-35, lines 65-67, col 14 lines 1-5), and

control means configured to allocate a network address to the recognized communication system under which the communication terminal apparatus can currently

be reached (col 14 lines 24-33) and communicating control information via the selected base station to a control network address stored in a memory of the communication apparatus (col 15 lines 33-46), for influencing an activation/deactivation condition related to another communication system not having the selected base station (col 7 lines 25-47); and

the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (col 15 lines 33-53).

Regarding **Claims 9-10**, Jarrett teaches a communication terminal apparatus wherein the control information activates a call redirection relating to a subscriber address under which the communication terminal apparatus can be reached via another communication system not having the selected base station (col 13 lines 9-25), given corresponding readiness to receive the another communication system by the communication terminal apparatus (col 11 lines 43-47).

Regarding **Claim 11**, Jarrett teaches a communication terminal apparatus wherein the memory stores a control network address of a mobility server (col 14 lines 41-67).

Regarding **Claim 12**, Jarrett teaches a communication terminal apparatus wherein the memory stores a plurality of control network addresses of a plurality of communication systems (col 14 lines 54-66), and the communication terminal apparatus further comprising:

selection means for selecting at least one control network address of another communication system not having the selected base station (col 15 lines 1-23).

***Response to Arguments***

3. Applicant's arguments filed on 1/21/05 have been fully considered but they are not persuasive.

In response to applicant's argument that Jarrett fails to show "a dual mode terminal which is responsible for the call redirection procedures by allocating the network address to the recognized subsystem and to control network address", the examiner asserts that Jarrett teaches comprises a wireless communication system. The wireless communication system is capable of communicating with a cellular network compatible mobile unit, also referred to as a mobile station herein. The cordless cellular base station, also referred to as a sub-regional base station, is preferably connected to a landline on a public switched telephone network and is assigned a landline number or phone number. The mobile station is registered with a cellular network and is assigned a mobile identification number. Advantageously, the mobile station is capable of communication with both a conventional regional cellular base station and to the cordless cellular base station utilizing the same cellular frequency range and communications protocol. When the mobile station is communicating with the cellular network, it is referred to as being in the regional cellular service mode. When the mobile station is communicating with the cordless cellular base station, it is referred to as being in cordless cellular telephone landline service mode. The mobile station of the present invention advantageously communicates with the autonomous base station and with the regional cellular base stations of the cellular network utilizing the same frequency range and the same communications protocol. The cordless cellular

base station is able to communicate with the mobile station and act as a conduit between the mobile station and the public switched telephone network. Further, despite the fact the mobile station is IS-136 compliant and can communicate with both analog and digital regional cells, the mobile station preferably communicates with the cordless cellular base station utilizing a digital control channel and corresponding digital traffic channels. By utilizing a digital channels, rather than analog and digital channels for communication with the mobile station, the hardware and software required to operate the cordless cellular base station is further reduced and thus the manufacturing costs are reduced (col 2 lines 30-67, col 3 lines 1-25). Once a mobile station receives registration privileges with a particular cordless cellular base station, the mobile station automatically registers with the cordless cellular base station when the mobile station comes into proximity with the cordless cellular base station. As the number of cordless cellular base station users increases it becomes more likely that at least some cordless cellular base stations will be operating in close proximity to one another. With base stations present in adjoining houses, for example, it is not desirable to enable automatic registration for all mobile station users that come into proximity with a cordless cellular base station, because it is possible for one neighbor to inadvertently automatically register with another neighbor's cellular base station. Advantageously, the automatic registration feature of the present invention allows the cordless cellular base station to restrict automatic registration to those users who have been previously pre-registered with a particular cordless cellular base station. By requiring pre-registration, before automatic registration occurs, accidental automatic registration with a nearby cordless cellular base station is prevented while still providing the convenience of automatic registration for frequent users. In addition, the mobile station will not attempt to

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automatically register with a cordless cellular base station unless it has previously registered with that cordless cellular base station and knows on which channels to look for the cordless cellular base station (col 3 lines 25-52). Jarrett teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (col 13 lines 25-35), the communication terminal apparatus being logged on as ready to receive the selected base station (col 11 lines 43-47), the communication terminal apparatus comprising: recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (col 13 lines 26-35, lines 65-67, col 14 lines 1-5), and control means configured to allocate a network address to the recognized communication system under which the communication terminal apparatus can currently be reached (col 14 lines 24-33) and communicating control information via the selected base station to a control network address stored in a memory of the communication apparatus (col 15 lines 33-46), for influencing an activation/deactivation condition related to another communication system not having the selected base station (col 7 lines 25-47); and the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (col 15 lines 33-53).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**5. Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

June 7, 2005

*Marsha D Banks-Harold*  
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